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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/089,549 | 04/01/2002 | Michio Kubota | KUBOTA=9 | 3265 |
| 1444 | 7590 | 01/12/2005 | EXAMINER | |
| BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303 | | | RAO, MANJUNATH N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1652 | |

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicant(s)

10/089,549

Applicant(s)

KUBOTA ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,4,8-15 and 43-46.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9-27-04, 11-23-04.
10. ☐ Other: _____

Manjunath N. Rao, Ph.D.
Primary Examiner
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Advisory Action

Claims 1, 3-4, 8-15, 43-46 are now currently pending in this application.

Applicant's request for reconsideration filed on 11-23-04 has been considered but NOT ENTERED, as it raises new issues and requires the Examiner to institute new rejections. The amendment has not been entered for the following reasons;

In response to the previous Office action, applicants have amended claim 1, and added new claims 47-51. However, said amendments and arguments presented are not persuasive to overcome the previous rejections and furthermore raises new issues for which Examiner will have to institute new rejections. For example, applicants have amended claim 1 extensively. However, they fail to point out the support for such amendments in the specification. A perusal of the specification does not fully support the claim 1 amendment. While Examiner did find support for an α -isomaltosylglucosaccharide-forming enzyme with a molecular weight of about 140,000 + 20,000 daltons on SDS-PAGE (page 69 of the specification), further support for the other characteristics of such an enzyme having the pI values of 5.2 + 0.2 or 7.3 + 0.5 was absent in the specification. The same was observed for the optimum temperature of said enzyme. Examiner was unable to find support for an optimum temperature of 40 to 50 degree C (in the absence of Ca²⁺) and 45 to 55 degree C in the presence of Ca²⁺. The support in the specification for that said enzyme was found to be 40 degree C (in the absence of Ca²⁺) and 45 degree C (in the presence of Ca²⁺, see page 69 of the specification). Similar lack of support was noted by the Examiner for thermal stability and pH stability as well. Examiner was also unable to find full support for the enzyme claimed in the new claim 48, specifically the optimum temperature values at the claimed pH values of 8.4. Therefore, claim 1 and 48 raises the issue of

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new matter. Furthermore, claim 1, line 11, recites the phrase “and having an amino” which makes no sense in the context of the amended claim and will have to be rejected under 35 U.S.C. 112, 2nd paragraph as indefinite if said amendment is entered.

Applicants continue to maintain the phrase “substantially increasing the reducing power” and traverse the previous rejection for the same under 35 U.S.C. 112, 2nd paragraph. Applicants argue that support for the traversal arguments can be found in Table 3, Table 7 etc. which are mainly devoted to the data regarding α -isomaltosyl-transferring enzyme and argue that it is just a typographical error that the table refers to α -isomaltosyl-transferring enzyme, and that it must actually read as α -isomaltosylglucosaccharide enzyme. Examiner respectfully disagrees with such an argument. This is because the specification clearly distinguishes between the above two enzymes and it cannot be arbitrarily accepted that the data points for one enzyme applies to another enzyme because it is a typographical error. If that was the typographical error it begs the question as to why applicants did not correct the same earlier. Applicants also argue that support for the above phrase can be found on page 131-133 wherein the definition is in the form of a equation. While it can be agreed that applicants have provided an equation for calculation of reducing power, said equation does not fully define as to how much increase in the reducing can be considered as a “substantial increase”. Without a specific numerical value attached to the phrase such as, for example, 30% increase in reducing power is considered as a substantial increase or a 40% increase in reducing power is considered as a substantial increase, the above phrase cannot be considered as definitive.

In view of all the above, the amendment submitted on 11-23-04 has not been entered as it raises new issues.

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Conclusion

None of the claims are allowable. All previous rejections are maintained for reasons of record.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.
Primary Examiner
Art Unit 1652

January 6, 2005